



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/538,227 | 06/08/2005 | Klaus Werner Leitner | MUI0008US2 | 9415 |

23413 7590 04/15/2010
CANTOR COLBURN, LLP
20 Church Street
22nd Floor
Hartford, CT 06103

| |
|----------|
| EXAMINER |
|----------|

MERCADO, JULIAN A

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1795

| | |
|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

04/15/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/538,227 | Applicant(s) LEITNER ET AL. | |
| | Examiner JULIAN MERCADO | Art Unit 1795 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9-3-09</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1795

DETAILED ACTION

Remarks

This Office action is responsive to applicant's amendment filed on January 22, 2010.

Claims 13-22 are pending for consideration.

Claim Rejections - 35 USC § 112

The rejection of claim 14 under 35 U.S.C. 112, second paragraph has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Besenhard et al. (U.S. Pat. 5,916,485).

The rejection is maintained for the reasons of record. Applicant's arguments filed with the present amendment have been fully considered, however they are not found persuasive for the following reasons. Applicant's argument is that Besenhard et al. does not teach using its SIC coating method to deposit onto the surface of an electrode substrate. This argument is not persuasive for the following reasons. It appears to the examiner that applicant's assertion is premised on the claimed electrode substrate being a planar body such as illustrated by electrode

Art Unit: 1795

substrate [10] or [20] in applicant's Figure 1 and Figure 2, and as exemplified by the specification on page 3, i.e. "[t]he electrode substrate is not particularly limited, and is preferably a current collector used in conventional electrodes...." To this end, as these features are not recited in the claims, the examiner asserts that the claims are given their broadest reasonable interpretation in a manner not inconsistent with applicant's disclosure, and while claims are read in light of the specification, specification limitations are not necessarily read into the claims. By its own nomenclature, "substrate-induced coagulation" or as abbreviated SIC requires some type of substrate in Besenhard et al. Indeed, the substrate is the material base on which the subsequent individual steps are built upon. See col. 5 lines 12-15 and lines 42-51. The argument that Besenhard et al. does not teach using its SIC coating method to deposit onto the surface of an electrode substrate is not persuasive given that the patentees specifically disclose coating carbon blacks onto PTFE powders by SIC coating methods, and in view of Besenhard et al. specifically teaching that these particulate solids have surfaces, i.e. "the substance triggering the [substrate-induced] coagulation must remain adherent to the surface of the substrate." See col. 4 lines 1-4. Furthermore, the PTFE powder is readable on the claimed electrode substrate as it a subcombination element of the claimed electrode as *prepared by* the claimed invention, and in view of Besenhard et al. specifically disclosing that powders prepared in this manner are part of a method of preparing a battery electrode such as "the support mesh and bypass grid for large battery electrodes." See col. 7 line 64 to col. 8 line 7.

If applicant intends for the claimed electrode substrate to be interpreted as the planar body as shown by [10] or [20] of the disclosure and somehow differentiate from the particulate

Art Unit: 1795

solids as otherwise disclosed by Besenhard et al., it is suggested to further amend the claims in a manner consistent therewith.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Besenhard et al. (U.S. Pat. 5,916,485).

The teachings of Besenhard et al. are discussed above.

The examiner notes applicant's reservation of right to illustrate additional reasons for non-obviousness such as a criticality of the claimed range. As no such arguments are presently submitted, Besenhard et al. is maintained under 35 U.S.C. 103(a) for the reasons set forth in the prior Office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1795

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

/Julian Mercado/
Examiner, Art Unit 1795

Application/Control Number: 10/538,227

Page 6

Art Unit: 1795

/PATRICK RYAN/

Supervisory Patent Examiner, Art Unit 1795